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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,798	12/28/2000	Thomas E. Donaldson	06975-146001/ Search2	6269
26171	7590	07/27/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			NGUYEN, CINDY	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/749,798

Applicant(s)

DONALDSON ET AL.

Examiner

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9-15 and 17-21 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

This is in response to amendment filed 05/10/05.

### ***Response to Arguments***

Applicant's arguments filed 05/10/05 have been fully considered but they are not persuasive.

Applicant argued that Yagasaki fails to describe or suggest classifying the search term and using the classification of the search term to select among multiple electronic information stores to perform a search and received the search term among at least first and second categories and using the classification of the search term to select among multiple electronic information stores to perform the search. In response, Yagasaki clearly disclose classifying the search term and using the classification of the search term to select among multiple electronic information stores to perform a search received the search term among at least first and second categories and using the classification of the search term to select among multiple electronic information stores to perform the search as the product has been classified into a plurality of categories to allow a customer to search for desired product, and creating product search (before classifying the categories) that contain the category selection menu see also col. 2, lines 9-26 and col. 6, lines 18 to col. 7, lines 48.

### ***Information Disclosure Statement***

The information disclosure statement filed on 05/10/05 and 01/19/05 are in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Because they have been placed in the application file, and the information referred to therein has been considered as to the merits.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 5 and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Yagasaki (US 6125353).**

Regarding claims 1 and 16, Yagasaki discloses: A method and a system for searching different data stores based on a classification of a search term, the method comprising:

receiving at least one search term (col. 6, lines 55-62, Yagasaki);

classifying the search term among at least first and second categories (col. 2, lines 9-26, Yagasaki);

using the classification of the search term to select among multiple electronic information stores to perform a search, wherein a first electronic information store contains first electronic information associated with at least a first category and second electronic information store contains second electronic information associated with at least a second category (col. 6, lines 32-45, Yagasaki);

when the search term is classified within the first category, performing the search after classifying the search term by comparing the search term only to the first electronic information within the first electronic information store to determine whether matches exist (54b, fig. 8, and corresponding text, Yagasaki);

when the search term is classified within the second and following the classification of the search term, performing the search by category comparing the search term to at least second electronic information within at least a second electronic information store that differs from the first electronic information store to determine whether matches exist (col. 6, lines 32-45 and col. 7, lines 5-12, Yagasaki);

displaying a result based on the matches that are determined to exist 45 (53a, 53b, 54, 54b, fig. 8, and corresponding text, Yagasaki).

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Yagasaki discloses: wherein comparing the search term when the search term is classified within the second category comprises comparing the search term to the first electronic information within the first electronic information store and to the second electronic information within the second electronic information store (53b and corresponding text, Yagasaki).

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Yagasaki discloses: wherein: receiving at least one search term comprises receiving several search terms and grouping the search terms received as a single string (any categories) (s7 fig 9 and corresponding text, Yagasaki);

classifying the search term comprises classifying the single string of search terms among at least first and second categories (s3, s8 fig. 9 and corresponding text0, Yagasaki);

comparing the search term when the single string of search terms is classified within the first category comprises comparing the single string of search terms to the first electronic information within the first electronic information store to determine whether matches exist (col. 7, lines 5-12, Yagasaki); and

comparing the search term when the single string of search terms is classified within the second category comprises comparing the single string of search terms to the second electronic information within the second electronic information store to determine whether matches exist (col. 7, lines 5-12, Yagasaki).

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Yagasaki discloses: wherein the method is performed by a web host having members and the method further comprises:

automatically scanning contents of a web site when the web site is accessed by members of the web host (col. 4, lines 31-52, Yagasaki)

classifying the contents of the web site among at least one of the first electronic information within the first electronic information store and the second electronic information within the second electronic information store (col. 4, lines 30-51, Yagasaki).

storing the contents of the web site in the first electronic information within the first electronic information store when the contents of the web site are classified among

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the first electronic information (store A-E fig. 8, 53b and corresponding text, Yagasaki);  
and

storing the contents of the web site in the second electronic information within the second electronic information store when the contents of the web site are classified among the second electronic information (store A-E fig. 8, 53b and corresponding text, Yagasaki).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yagasaki (US 6125353) in view of Russell-Falla et al. (U.S 6266664) (Russell).**

Regarding claim 4, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Yagasaki discloses: wherein the first electronic information includes contents relating to non-offensive web sites (col. 8, lines 29-51, Yagasaki). However, Yagasaki didn't disclose: the second electronic information includes contents relating to offensive web sites. On the other hand, Russell discloses: the second electronic information includes contents relating to offensive web sites (col. 5, lines 9-20, Russell). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the offensive web sites in the

combination system of Yagasaki as taught by Russell. The motivation being to screen for offensive materials from web sites.

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 5. In addition, **Yagasaki/Russell** disclose: wherein the first electronic information store is located on a first server (col. 4, lines 25-39, Yagasaki) and the second electronic information store is located on a second server that differs from the first server (10, fig. 1 and corresponding text, Russell).

**Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yagasaki (US 6125353) in view of Sundaresan et al. (U.S 6606620).**

Regarding claims 7 and 8, all the limitations of this claim have been noted in the rejection of claim 1. However Yagasaki didn't disclose: wherein the first and the second electronic information includes full text, titles, descriptions, and addresses of web sites such that the comparing the search term to the first electronic information within the first electronic information store comprises comparing the search term to the full text, the titles, the descriptions and the addresses of web sites to determine whether matches exist. On the other hand, Sundaresan discloses: wherein the first and the second electronic information includes full text, titles, descriptions, and addresses of web sites such that the comparing the search term to the first electronic information within the first electronic information store comprises comparing the search term to the full text, the titles, the descriptions and the addresses of web sites to determine whether matches



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exist (col. 7, lines 38-44, Sundaresan). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the step of comparing the search term to the addresses of web sites to determine whether matches exist in the combination system of Yagasaki as taught by Sundaresan. The motivation being to enable users to choose the most relevant hits without the loss of information.

***Allowable Subject Matter***

Claim 9-15, 17-21 allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record and that encountered while searching for the claimed invention fails to anticipate and/or suggest: a method and a computer program for storing searchable and retrievable content into more than one distinct electronic information store, the method comprising detecting a number of accessible and retrievable content, comparing the number of detected access to a threshold number if the threshold number is met, scanning the searchable and retrievable content in response to the searchable and retrievable content being accessed the threshold number of time as recited in claims 9 and 19.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record and that encountered while searching for the claimed invention fails to anticipate and/or suggest: A system for storing searchable and retrievable content among more than one distinct electronic information store, comprising: wherein the first electronic information store and the second electronic

information are populated by searchable and retrievable content that has been automatically scanned when a detected number of accesses of the searchable and retrievable content has met a threshold number of accesses as recited in claim 14.

Regarding claims 10-13, 15, 17, 18 and 20-21, these claims depend from claims 9, 14, and 19 respectively and are therefore allowable.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***1. Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on M-F: 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*CN*

Cindy Nguyen

July 18, 2005

*Frantz Coby*  
**FRANTZ COBY**  
**PRIMARY EXAMINER**